Our Reference: 10992014-1 PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Appellant:	Daniel Lee Briley
Serial Number:	10/086,311
Filing Date:	March 1, 2002
Confirmation No.:	8556
Examiner/Group Art Unit:	Fadey S. Jabr
Title:	POSTAGE EVIDENCE THAT INCLUDES NON-VISIBLE MARKS

APPEAL BRIEF

Mail Stop Appeal Brief – Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Please enter the following Appeal Brief in the appeal filed May 5, 2008.

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I. REAL PARTY IN INTEREST

The real party in interest is Assignee, Hewlett-Packard Development Company, L.P., a limited partnership established under the laws of the State of Texas and having a principal place of business at 20555 S.H. 249, Houston, Texas 77070, U.S.A. (hereinafter "HPDC"). HPDC is a Texas limited partnership and is a wholly-owned affiliate of Hewlett-Packard Company, a Delaware Corporation, headquartered in Palo Alto, CA. The general or managing partner of HPDC is HPQ Holdings, LLC.

II. RELATED APPEALS AND INTERFERENCES

Appellant and the undersigned attorneys are not aware of any appeals or any interferences which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

III. STATUS OF CLAIMS

Claims 1, 4-11 and 14-20 are the claims on appeal. *See,* Appendix.

Claims 2, 3, 12, 13, and 21-44 were cancelled.

Claims 1, 4-11 and 14-20 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Leon (U.S. Patent No. 6,701,304 B2).

IV. STATUS OF AMENDMENTS

In response to the Final Office Action of February 4, 2008, no amendment pursuant to 37 C.F.R. § 1.116 was filed.

V. SUMMARY OF CLAIMED SUBJECT MATTER

In this summary of claimed subject matter, all citations are to the specification of United States Patent Application 10/086,311. Further, all citations are illustrative, and support for the cited element may be found elsewhere in the specification.

Independent claim 1:

One embodiment provides a mail system configured to process postage evidence on a mail piece (page 4, lines 17-18). The mail system comprises: a handling system configured to receive the mail piece (page 5, line 12), scan the postage evidence for visible marks and non-visible marks to read visible mark information indicated by the visible marks and non-visible mark information indicated by the non-visible marks (page 5, lines 2-6; page 9, lines 16-20; and Figures 2 and 4), and transfer the visible mark information and the non-visible mark information (page 5, lines 7-8); and a processing system coupled to the handling system and configured to process the visible mark information and the non-visible mark information to generate postage information for the mail piece (page 5, lines 9-10). The handling system is further configured to scan the non-visible marks using an Ultra Violet (UV) or an Infrared (IR) light (page 5, lines 6-7), and to process information in the non-visible marks to validate information in the visible marks (page 8, lines 11-12; page 8, lines 16-17). The non-visible marks are also detectable by human eye using a UV light for human confirmation of the non-visible marks (from page 6, line 25 to page 7, line 2; page 9, lines 20-21; and Figures 2 and 4).

Independent claim 11:

One embodiment provides a method for processing postage evidence on a mail piece (page 7, lines 11-12; page 9, lines 23-24; and Figures 2 and 4). The method

comprises: receiving the mail piece (page 9, line 16; and Figure 4); scanning the postage evidence for visible marks and non-visible marks to read visible mark information indicated by the visible marks and non-visible mark information indicated by the non-visible marks (page 5, lines 2-6; page 9, lines 16-20; and Figure 4); and processing the visible mark information and the non-visible mark information to generate postage information for the mail piece (page 7, lines 11-12; page 9, lines 23-24; and Figures 2 and 4). The non-visible marks are scanned using an Ultra Violet (UV) or an Infrared (IR) light (page 5, lines 6-7). The nonvisible marks are also detectable by human eye using a UV light for human confirmation of the non-visible marks (from page 6, line 25 to page 7, line 2; page 9, lines 20-21; and Figure 2).

VI. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

Whether claims 1, 4-11 and 14-20 are unpatentable under 35 U.S.C. § 103(a) over *Leon*.

VII. ARGUMENTS

A. Rejection of claims 1, 4-11 and 14-20 under 35 U.S.C. § 103(a), as being unpatentable over Leon

Claims 1, 4-11 and 14-20 were rejected under 35 U.S.C. §103(a) as being unpatentable over Leon ("Method and Apparatus for Postage Label Authentication") in the Final Office Action dated February 4, 2008.

In section 4 of the Final Office Action dated February 4, 2008, the Examiner states that Leon discloses a method for postage label authentication which comprises the following steps: receiving the mail piece; scanning the postage evidence for visible marks and non-visible marks to read visible mark information indicated by the visible marks and non-visible mark information indicated by the non-visible marks, and the non-

visible marks are also detectable by the human eye using a UV light; and processing the visible mark information and the non-visible mark information to generate postage information for the mail piece.

In contrast, the elements set out in claims 1 and 11 of the instant application recite, in some form, that visible mark information and non-visible mark information is processed "to **generate postage information** for the mail piece." As defined in Appellant's specification as filed, at page 6, lines 22-23, "[p]ostage information includes any information that is related to the **delivery** of a mail piece" (emphasis added). Examples of postage information include a postage amount, a date, an origination address, a destination address, security information, or the like (see page 9, line 24 through page 10, line 1).

In sharp contrast, column 3, lines 4-8 of Leon (as cited by the Examiner) discloses an embodiment of a postage label **authentication** system. This system uses data, symbology, and marking readers to read/detect human-readable and machine-readable indicia printed on a postage label. A computer receives information from the readers and provides a yes/no **status signal that indicates whether the postage is authentic**.

Thus, in the above description of the steps disclosed in the method of Leon, the Examiner is ignoring the fact that Leon does not disclose "generat[ing] postage information for the mail piece." In fact, Leon is describing providing only a yes/no status signal that indicates whether the postage is authentic. It is not describing the various kinds of postage information generated in the instant application. When challenged on this point, the Examiner recited case law that claims directed to an apparatus must be distinguished from the prior art in terms of structure rather than function.

This case law, however, regarding distinguishing claims directed to an apparatus is inapplicable to the instant application for the following reasons. Leon is being asserted against independent claims 1 and 11 and their respective dependent claims. Claim 1 and its dependent claims are system/apparatus claims. Instant claim 1 recites: "a processing system coupled to the handling system and **configured** to process the

visible mark information and the non-visible mark information to generate postage information for the mail piece". The above (and similar) claim recitation(s) after "configured" should be interpreted as **structural** rather than functional limitations (which the Examiner is ignoring, citing In re: Danly). The Examiner also cites Ex parte Masham, stating that "[a] claim containing a 'recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus' if the prior art apparatus teaches all the structural limitations of the claim."

The Federal Circuit spoke to the issue of intended use providing a positive structural limitation in Corning Glass Works v. Sumitomo Electric U.S.A., Inc., et al., 868 F.2d 1251, 1257 (Fed. Cir. 1989):

> Thus, we conclude that the claim preamble in this instance **does not merely state a purpose or intended use for the claimed structure**. *See* Kropa v. Robie, 38 C.C.P.A. 858, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951). Rather, those words do give "life and meaning" and provide further **positive limitations** to the invention claimed. *See* Loctite, 781 F.2d at 866, 228 USPQ at 92; Perkin-Elmer Corp. v. Computervision Corp., 732 F.2d 888, 896, 221 USPQ 669, 675 (Fed. Cir.), cert. denied, 469 U.S. 857, 83 L. Ed. 2d 120, 105 S. Ct. 187 (1984). Thus, contrary to Sumitomo's argument, the core and cladding limitations specifically set out in paragraphs (a) and (b) are not the only limitations of the claim. *See*, e.g., Diversitech Corp. v. Century Steps, Inc., 850 F.2d 675, 677-78, 7 USPQ2d 1315, 1317 (Fed. Cir. 1988) (affirming district court's use of claim preamble as a limitation). **The claim requires, in addition, the particular structural relationship defined in the specification for the core and cladding to function as an optical waveguide**. (emphasis added)

Following the Federal Circuit's guidance in Corning Glass, each of the claim recitations after "configured" is a positive, **structural** limitation, and *not* merely intended use. The definition of "configured" is "set up for operation, especially in a particular way" (http://www.merriam-webster.com/dictionary/configured). Such a definition clearly implies a structure or structures.

In the system of claim 1, a structure of the processing system is being described which processes the mark information to generate postage information. In light of the above, in claim 1, the limitation "a processing system coupled to the handling system and **configured** to process the visible mark information and the non-visible mark information to generate postage information for the mail piece" is a **structural** limitation and should be interpreted as a structural limitation. Leon, therefore, fails to teach or suggest all of the elements of the instant application as set out in claim 1 and its dependent claims, since it does not teach or suggest "a processing system coupled to the handling system and configured to process the visible mark information and the non-visible mark information to generate postage information for the mail piece."

Claim 11, on the other hand, is not a system claim, but a method claim. No apparatus is being claimed. Rather, as with all method claims, a step or series of steps is being used to establish the metes and bounds of a method. In the case of claim 11, the steps set out in the claim are drawn to the method for processing postage evidence on a mail piece. No apparatus or structure is implied or intended. Since claim 11 and its dependent claims are all method claims, they are entitled to the benefit of functional limitations for distinguishing them over the prior art.

For all the above reasons, Leon fails to teach or suggest all of the elements of the instant application as set out in method claim 11 and its dependent claims, as well as in system claim 1 and its dependent claims.

As stated in M.P.E.P. §2143, "[t]he key to supporting any rejection under 35 U.S.C. 103 is the clear articulation of the reason(s) why the claimed invention would have been obvious. The Supreme Court in *KSR* noted that the analysis supporting a rejection under 35 U.S.C. 103 should be made explicit." In the current §103(a) rejection under Leon, the Examiner has not provided a reference or any kind of evidence that the limitation "process[ing] the visible mark information and the non-visible mark information to generate postage information for the mail piece" was previously known or suggested in the art. Rather, the Examiner has merely dismissed the limitation as a "functional

limitation." As shown above, for various reasons such a dismissal of the limitation was not an appropriate basis for rejection under §103(a) of any of the pending claims.

Several exemplary rationales are given in §2143. Most of these rationales deal with modifying a prior art reference by combination of a known method, element, technique, solution, or work with the prior art reference. Since the Examiner in the present case did not actually consider the alleged "functional" limitation in making the §103(a) rejection based on Leon, the Examiner did not go further in the analysis to provide any basis for modifying Leon based on known methods, techniques, etc. Therefore, it appears that most of the exemplary rationales given in M.P.E.P. §2143 could not apply in the current §103(a) rejection. If, hypothetically, any could possibly be considered an appropriate rationale, rationale (G) might be considered, since it requires only a general "teaching, suggestion, or motivation in the prior art that would have led one of ordinary skill to modify the prior art reference."

As §2143 states about rationale (G): "To reject a claim based on this rationale, Office personnel must resolve the *Graham* factual inquiries. Then, Office personnel must articulate the following:

(1) a finding that there was some teaching, suggestion, or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings;

(2) a finding that there was reasonable expectation of success; and

(3) whatever additional findings based on the *Graham* factual inquiries may be necessary, in view of the facts of the case under consideration, to explain a conclusion of obviousness.

The Examiner in the §103(a) rejection based on Leon has failed to show that any of the above findings has been made. By dismissing out of hand as "functional" the limitations in claims 1 and 11 dealing with "process[ing] the visible mark information and the non-visible mark information to generate postage information for the mail piece," the Examiner has not made explicit that analysis supporting a rejection under 35 U.S.C. 103

as required by the Supreme Court in *KSR*. By failing to make such an analysis explicit, the Examiner has failed to support any rejection under 35 U.S.C. 103.

SUMMARY

The Appellant respectfully submits that claims 1, 4-11 and 14-20 as currently pending fully satisfy the requirements of 35 U.S.C. § 103. In view of the foregoing, favorable consideration and passage to issue of the present application is respectfully requested. If any points remain in issue that may best be resolved through a personal or telephonic interview, the Examiner is respectfully requested to contact the undersigned at the telephone number listed below.

Respectfully submitted,

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VIII. CLAIMS APPENDIX

1. (Previously presented) A mail system configured to process postage evidence on a mail piece, the mail system comprising:

a handling system configured to receive the mail piece, scan the postage evidence for visible marks and non-visible marks to read visible mark information indicated by the visible marks and non-visible mark information indicated by the non-visible marks, and transfer the visible mark information and the non-visible mark information; and

a processing system coupled to the handling system and configured to process the visible mark information and the non-visible mark information to generate postage information for the mail piece;

wherein the handling system is further configured to scan the non-visible marks using an Ultra Violet (UV) or an Infrared (IR) light, and to process information in the non-visible marks to validate information in the visible marks; and

wherein the non-visible marks are also detectable by human eye using a UV light for human confirmation of the non-visible marks.

2. (Cancelled)

3. (Cancelled)

4. (Original) The mail system of claim 1 wherein the processing system is further configured to process the non-visible mark information and use the non-visible mark information in combination with the information in the visible mark information to validate the postage evidence.

5. (Original) The mail system of claim 4 wherein the non-visible mark information comprises a key to validate the information in the visible mark information.

6. (Original) The mail system of claim 1 wherein the processing system is further configured to process the non-visible mark information and the visible mark information using a checksum algorithm.

7. (Original) The mail system of claim 1 wherein the visible marks and the nonvisible marks comprise a bar code.

8. (Original) The mail system of claim 7 wherein the visible marks and the nonvisible marks comprise Information Based Indicia (IBI).

9. (Original) The mail system of claim 1 wherein the postage information includes a postage amount.

10. (Original) The mail system of claim 9 wherein the postage information includes a date, an origination address, a destination address, and security information.

11. (Previously presented) A method for processing postage evidence on a mail piece, the method comprising:

receiving the mail piece;

scanning the postage evidence for visible marks and non-visible marks to read visible mark information indicated by the visible marks and non-visible mark information indicated by the non-visible marks, wherein the non-visible marks are scanned using an Ultra Violet (UV) or an Infrared (IR) light, and wherein the nonvisible marks are also detectable by human eye using a UV light for human confirmation of the non-visible marks; and

processing the visible mark information and the non-visible mark information to generate postage information for the mail piece.

12. (Cancelled)

13. (Cancelled)

14. (Original) The method of claim 11 further comprising processing the nonvisible mark information to validate the postage evidence.

15. (Original) The method of claim 14 wherein the non-visible mark information comprises a key to the visible mark information.

16. (Original) The method of claim 11 further comprising processing the nonvisible mark information and the visible mark information using a checksum algorithm.

17. (Original) The method of claim 11 wherein the visible marks and the nonvisible marks comprise a bar code.

18. (Original) The method of claim 17 wherein the visible marks and the nonvisible marks comprise Information Based Indicia (IBI).

19. (Original) The method of claim 11 wherein the postage information includes a postage amount.

20. (Original) The method of claim 19 wherein the postage information includes a date, an origination address, a destination address, and security information.

21-44. (Cancelled)

IX. EVIDENCE APPENDIX

From online Merriam-Webster dictionary at http://www.merriam-webster.com/dictionary/configured:

"configured"

Main Entry:
con·fig·ure
Pronunciation:
\kən-ˈfi-gyər, *especially British* -ˈfi-gər\
Function:
transitive verb
Inflected Form(s):
con·fig·ured; **con·fig·ur·ing**
Date:
1677
: to set up for operation especially in a particular way <a fighter plane *configured* for the Malaysian air force>

X. RELATED PROCEEDINGS APPENDIX

None.